



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/609,446	06/27/2003	Robert J. Schuller	VCI 0430 PUS	3976

22045 7590 02/11/2009
BROOKS KUSHMAN P.C.
1000 TOWN CENTER
TWENTY-SECOND FLOOR
SOUTHFIELD, MI 48075

EXAMINER

CARLSON, JEFFREY D

ART UNIT	PAPER NUMBER
----------	--------------

3622

MAIL DATE	DELIVERY MODE
-----------	---------------

02/11/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/609,446

Applicant(s)

SCHULLER ET AL.

Examiner

Jeffrey D. Carlson

Art Unit

3622

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 9-22 and 28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 9-22 and 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to the paper(s) filed 11/17/2008.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1-6, 9-22, 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hewitt et al ('797') (US Pat 5578797) further in view Sheehan (US2002/0178060).**
4. Regarding claims 1, 6, 9-10, 14, 16, Hewitt et al ('797') teaches a scale in a perishable store department that accepts identification of a product (i.e. PLU), weighs and prices identified products (such as perishable bagels). The scale prints label portions that include information about the identified product, a price for the weighed product and a barcode for easily identifying the product and its price at the POS as is generally known [fig 6A]. Hewitt et al ('797') also teaches a label portion that includes incentive identifying information - an incentive coupon for a discount on a product different from, but related to the weighed product; the coupon has a barcode for easy identification and redemption at the POS [col 4: lines 47-52, 5:1-4, 20-23]. The customer buying the bagels and choosing to also purchase the incentive cream cheese presents both products and the coupon which results in an automatic discount as is

generally accepted with POS systems. Regarding the language that the printed "incentive identifying information is other than any incentive code", Hewitt et al ('797') indeed teaches incentive information printed in a narrative, human-friendly form ("50 on one 9oz packet of BEST FOODS CAJUN SPICES") so that the customer can be alerted to the offer and can add the incentive item to his cart. This information is taken to be a label portion that is "code-free". However, the definition in applicant's specification is taken to define the "code-free" claim limitation as one where there is no coupon code or coupon barcode to enter at the POS – the originating product code is sufficient to index the related incentive(s). The printed matter on the label (or lack of printed code) is taken to be non-functional descriptive material unless applicant also claims steps/functionality/hardware that can accomplish the automated incentive discounting without the need for a separate incentive code or barcode – the claims are however taken to include this necessary steps/functionality/hardware. In this manner, Hewitt et al ('797') does not teach coupons redeemed without some sort of coupon-specific entry at the POS. Sheehan however teaches the concept of electronic coupons which are associated with an identifier. In this manner, only the parent identifier need be scanned/entered at the POS and the associated coupons can be identified. Sheehan describes the benefit:

[0021] Electronic coupons also save time at the time of checkout and reduce the possibility of error. Instead of having to enter each coupon manually or scan each paper coupon, one swipe of a smart card or **one check of a centralized database (performed, perhaps, during a credit check) would allow all appropriate electronic coupons to be processed.**

The processing and redemption of the quick, accurate and convenient electronic coupons is accomplished by recognizing the products presented for purchase and by detecting matches in a database of coupons/incentives that specify the identities of required products. If there is a match (i.e. the consumer is buying the appropriate products), the purchase is automatically discounted without requiring the consumers to carry, present or scan coupons at the point of purchase.

[0116] When the consumer proceeds to the retailers and buys a product or service associated with a stored electronic coupon (Operation 1210), and presents their club card (Operation 1212) **the retailer's system accesses the electronic coupon (which may be stored in the retailer's database at the head-end, backend or otherwise) and correlates the coupon against the items purchased (Operation 1214). When a correlation exists, the retailer's system the automatically deducts the coupon from the purchase price and the transaction is completed (Operation 1216).** As such, in this embodiment, an electronic coupon is associated with a specific retailer (or chain of stores) such that a consumer need only utilize a club card in order to gain the benefit of an electronic coupon.

It would have been obvious to one of ordinary skill at the time of the invention to have stored the incentive offers desired by Hewitt et al ('797') as well as the offers' required products in a database and to have eliminated the need to: print incentive barcodes, carry around the barcodes/coupons and present the coupon barcode at the POS for scanning, but rather relied upon an incentive/pricing/product database so that the discounts can be realized without the added hassle of paper-based coupons in the manner of and for the benefits associated with Sheehan.

5. Regarding claims 2-4, 11-12, 17, the label of fig 6A can be reasonably taken to be a single product label including a product portion and a coupon portion. Fig 6A can

also be reasonably taken to provide two labels (a product label and a coupon label separated by a perforation boundary). Certainly when the customer separates the label at the perforation as directed by Hewitt et al ('797'), what results is two labels with respective printing on them. Hewitt et al ('797') also teaches displaying coupon information on a display [6:4-10]. This is taken to represent printing incentive information to non-label media.

6. Regarding claims 5, 13, it would have been obvious to one of ordinary skill at the time of the invention to have offered multiple coupons (such as buy weighed hamburger patties - get a coupon for ketchup and a coupon for mustard), as a mere duplication of parts. MPEP 2144.04. Where giving a coupon is seen as advantageous, one of ordinary skill would find it predictably advantageous to offer multiple coupons for related items, thus encouraging even more purchases.

7. Regarding claim 15, Hewitt et al ('797') prints a message encouraging the customer to also purchase the targeted related product. Hewitt et al ('797') identifies the product name and description so that the customer can understand what is being offered. It would have been obvious to one of ordinary skill at the time of the invention to have further explained to the customer where the product is located so as to help the customer find the product being encouraged for purchase. Further, the "BEST FOODS CAJUN SPICES" language acts as information indicating where in the store the item is located – i.e. in the Spices section. Further still, the differences between the incentive information printed by Hewitt et al ('797') and the location information in the claims is only found in the nonfunctional descriptive material and is not functionally related to the

structure of the apparatus. The printer and associated structure is provided the same regardless of the content to be printed. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of Patentability, see *In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to one of ordinary skill at the time of the invention to have printed any type of data content.

8. Regarding claims 18-22, 28, these claims specifically call for a printed "single incentive code" where claim 1 calls for the absence of such an incentive code.

However, Hewitt et al ('797') indeed teaches the use of a printed incentive code [see FIG 6A]. It has been previously argued as obvious to have provided multiple incentives (ketchup, mustard) for a singled weighed product such as hamburger patties. Given the teachings of Sheehan to associate a plurality of electronic coupons with a single parent identifier, such as a club card identifier being associated with plural coupons, it would have been obvious to one of ordinary skill at the time of the invention to have associated the obvious plural incentives (ketchup, mustard coupons) with its parent identifier (the incentive code representative of the weighed/purchased hamburger patties). These are typical one-to-many relationships which are routinely represented and indexed with the types of relational database employed by routinely skilled artisans as well as Sheehan. This is in alignment with the teachings of Sheehan whereby the individual coupon barcodes (ketchup coupon, mustard coupon) need not be each scanned at the POS, but rather a single identifier can be presented and the system can automatically match and identify the associated child coupons. Therefore it would have

been obvious to one of ordinary skill at the time of the invention to have scanned a single incentive barcode of Hewitt et al ('797') which enables the system to locate a plurality of eligible coupon offers (ketchup coupon, mustard coupon, etc) in association with the eligible hamburger patties. Further regarding claim 21, it would have been obvious to one of ordinary skill at the time of the invention to have required the customer to present the originating weighed product/productID when redeeming the earned coupon(s). Otherwise, customer might pretend they wanted to buy the weighed shrimp just to get a coupon for the spices. One of ordinary skill would recognize the need to verify the qualifying purchase before the related incentive was granted.

9. Claims 4, 12 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Hewitt et al ('797') in view of Sheehan as above, and further in view of AC-3000 (Ishida AC-3000 Series brochure, 6 pages – cited by applicant 6/27/2003).

10. Regarding claims 4, 12, AC-3000 teaches the ability for such a scale to print to adhesive labels as well as to receipts. Hewitt et al ('797') also teaches that the targeted coupon need not be printed on the weighed product's label as in fig 6A - it can be merely displayed [6:4-10]. Official notice is also taken that it is well known to print coupons and other incentive information on a receipt. It would have been obvious to one of ordinary skill at the time of the invention to have printed the desired related coupon information on the customer's receipt. Doing so would not require the customer to go to the trouble of tearing the coupon from the product label.

Response to Arguments

11. Applicant's arguments filed 11/17/2008 have been fully considered but they are not persuasive.
12. While applicant recognizes a teaching of Sheehan that a check with a database allows all appropriate coupons to be processed, applicant argues that Sheehan fails to provide an enabling disclosure how electronic coupons would be processed at checkout other than checking a centralized database during a credit check. It is not clear how applicant's claims differ in terms of electronic redemption. Examiner has made for more detailed explanation describing his position. It is not clear how the teaching of Sheehan which includes matching discount offers in a database to the products presented for purchase and the automated recognition of eligible discounts as well as the automated reduction in price at the POS fall short of an enabling electronic redemption process. Further not clear is what exactly are the hurdles needed to be overcome which leads to applicant's assertion of experimentation. And it is further still unclear why if any experimentation was needed, what is particularly difficult for one of ordinary skill where the experimentation would be considered to be undue.
13. In contrast a first set of claims that call for a lack of incentive code, another set of claims actually *require* an incentive code. For these, applicant argues that Sheehan fails to teach reading of three codes – weighed product code, incentive product code and an incentive code. However, the rejection is made with Hewitt et al ('797') in view of Sheehan where Hewitt et al ('797') teaches reading of an incentive code, weighed

product code and the incentive product code. What is missing from Hewitt et al ('797') for these types of claims however is the idea to couple a single inventive code with multiple incentives. However as described above, this is taken to have been obvious at the time of the invention.

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Monday-Fridays; off alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey D. Carlson/
Primary Examiner, Art Unit 3622

Jeffrey D. Carlson
Primary Examiner
Art Unit 3622